

REMARKS

The Examiner's attention to the application is appreciated. The Office Action of September 30, 2002 has been carefully reviewed along with the prior art cited therein. Claims 1-6, 10, 53, 54 and 63-69 are pending in the application.

I. Rejection of Claims 1-6, 10, 53-54 and 63-69 under 35 U.S.C. §112, second paragraph

Claims 1-6, 10, 53-54 and 63-69 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Office Action suggests that in independent Claims 1-5, the phrase, "such that sheet label material can be positioned between the left-side tray wall," is indefinite. The Examiner was correct in the interpretation that sheet label material is not required in combination with the storage device. Applicant has amended independent Claims 1-5, to clarify that the sheet label material is not being claimed in independent Claims 1-5. Support for the amendment is found, for example, in the Specification, page 3, lines 4-7 and lines 12-15, page 15, lines 24-27, and page 42, lines 8-28, indicating that sheet label can optionally be placed with the storage device.

In dependent Claim 54, the Office Action suggests that no additional structural limitation is being claimed. In response, the Applicant has amended Claim 54 to recite, "... wherein the *height* of the front-side tray wall does not prevent inserting the disc media into the cavity through the opening in the front side of the case." The Specification, page 43, lines 8-14 supports this amendment.

It is respectfully submitted that these amendments overcome the rejections of §112, second paragraph.

II. Rejection of Claims 1-3, 10, 63, 65, 66, 67 under 35 U.S.C §103(a)

The Office Action has rejected Claims 1-3, 10, 63, 65, 66, 67 under 35 U.S.C §103(a) as being unpatentable to Akeret, U.S. Pat. No. 4,763,962.

The Office Action asserts that Akeret discloses a storage device comprising a media storage container in Figures 9, 12 and 13-15. The Office Action also asserts that it would

have been obvious to determine the size of the storage device through routine experiments. Applicant respectfully traverses this rejection and respectfully requests reconsideration.

Ackeret's housing 250 (Figure 13) fails to teach or suggest "at least sufficient clearance such that sheet label material can optionally be positioned between the left-side tray wall and the left-side case wall and between the right-side tray wall and the right-side case wall," as in Claims 1-3 of the present invention. Rather, Ackeret discloses a housing 250 that supports disc holders 270 that move relative to the housing with their associated slider member (Ackeret, lines 26-34, Figure 13). Ackeret's container includes a complex spring system that is designed to accommodate a plurality of compact discs (See, for example, Column 14, lines 21-38, Figures 41-44). Nowhere in Ackeret is there mention of sheet label material. Indeed, it would be against the teachings of Ackeret because Ackeret discloses accommodating compact discs or other flat recording media in a very dense stack within the housing (Ackeret, Column 2, lines 15-17). There is no clearance within Ackeret's container by which a "sheet label material can optionally be positioned between the left-side tray wall and the left-side case wall and between the right-side tray wall and the right-side case wall . . ." as in independent Claims 1-3 of the present invention.

Not only are the limitations of Claims 1-3 not taught or suggested by Ackeret's housing 250, the limitations of Claims 1-3 are not taught or suggested by Ackeret's disc holders 270 that are stacked with housing 250 (Figure 13, Column 8, lines 26, 34). The disc holder of Ackeret is designed to accommodate a disc or CD (Figure 19). The disc holder sometimes includes a hubb by which to hold the disc within the disc tray (Column 11, lines 19-21). The holders 270 may include cut-away portions 340 in order to permit the disc 330 to be grasped at a pair of oppositely disposed points on its periphery, so that the disc may be lifted upwardly off the hub 336 (Figure 9, lines 12-24). Ackeret fails to teach or suggest a clearance within Ackeret's container by which a "sheet label material can optionally be positioned between the left-side tray wall and the left-side case wall and between the right-side tray wall and the right-side case wall . . ." as in Claims 1-3 of the present invention. Thus, all the limitations of Claims 1-3 are not taught or suggested by Ackeret. Moreover, one skilled in the art would not be motivated to alter Ackeret's disc holder 270 to arrive at the independent Claims 1-3, since each of Ackeret's disc holders are designed to accommodate discs, so they are provided with their own biasing spring 632 and their own locking system. Thus, there is no motivation to alter such spring and locking system of the disc holders to

accommodate sheet label material as in Claims 1-3 (See, for example, Column 14, lines 21-38, Figures 41-44).

The Office Action further asserts that it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the outer container transparent, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design choice.” *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). In this case, a selection of a known plastic to make a container of a type made of plastics prior to the invention was held to be obvious. *Id.* However, the *In re Leshin* case is distinguishable from the case at hand because the intended purpose is not only to store compact discs, as in Akeret, but also to store sheet label material between the left-side tray wall 203 and the left-side case wall 103 and between the right-side tray 204 wall and the right-side case wall 104 (FIGS. 25-27). In this way, viewing of any sheet label material placed between the case 100 and the tray 200 can be facilitated (page 42, lines 29-32, Figures 29-33). For that reason, Akeret fails to teach or suggest “at least a portion of each of the left-side and right-side tray walls are at least sufficiently transparent to see sheet label material therethrough,” as recited in the Claims 1-3 of the present invention.

Because all of the elements of the invention of Claims 1-3 are not taught or suggested, obviousness has not been established for Claim 1. Akeret fails to teach or suggest all the limitations of independent Claims 1-3 and the Claims dependent thereon.

III. Allowable Subject Matter

The Office Action has stated that Claims 4-6, 53, 54, 64, 68-69 would be allowable if rewritten to overcome the rejection under 35 U.S.C §112, second paragraph, and to include all of the limitations of the base claim and any intervening claims. Accordingly, the Applicant respectfully requests the Office Action to pass 4-6, 53, 54, 64, 68-69 to issue.

IV. Conclusion

In view of the foregoing amendments and remarks, the Applicant respectfully urges that all pending claims are in condition for allowance and solicits Notice of Allowance for Claims 1-6, 10, 53, 54 and 63-69.

If the Examiner is of the opinion that a telephone conference would speed prosecution of the application, please do not hesitate to call Todd Albanesi at 214-220-0444.

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